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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,877	04/17/2006	Saburo Nakamura	80108(302725)	2222

21874 7590 06/23/2008  
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EXAMINER
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BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

MAIL DATE	DELIVERY MODE
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06/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,877	<b>Applicant(s)</b> NAKAMURA, SABURO	
	<b>Examiner</b> Greg Binda	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 and 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

*Election/Restrictions*

1. Applicant's election without traverse of the boot shown in Figs. 9-11 (Species III) in the reply filed on May 27, 2008 is acknowledged.
2. Claims 2-4 & 10-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 27, 2008.

*Information Disclosure Statement*

3. The listing of references in the specification as at page 2 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
4. The information disclosure statement filed October 4, 2007 fails to comply with the provisions of 37 CFR 1.98(b) because the reference titled "Russian Language Request of Expertise" is not identified with a publication date. The reference has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the

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date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.04(a) ¶ I.

### *Drawings*

5. The drawings are objected to because:

- a. In Fig. 10 the reference numeral 36 should be changed to 136.
- b. Reference character h1 appears in Fig. 11A, but does appear to be mentioned in the description.
- c. Position (1) appears in Fig. 11, but does not appear to be mentioned in the description.

6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

7. The disclosure is objected to because:
  - a. Page 1, line 16 reads, “refer to claims in patent document” 1.
    - i. The patent document 1 must be identified by its publication number.
    - ii. The claims in patent document 1 are written in a foreign language and so the specification must include a description the relevant subject matter to which the claims refer.
  - b. The following portions of the specification are not written in clear narrative form part. Each is instead a single overly long cumbersome sentence cut and pasted out of the claims:
    - i. Page 1, line 18 through page 2, line 6.
    - ii. Page 2, line 24 through page 3, line 17.
    - iii. Page 4, line 23 through page 5, line 12.
  - c. Page 20, line 13, the reference numeral 32a should be changed to “132a”.
  - d. Page 23, lines 16 & 17 includes the nonsensical phrase “even if the grease leaks into the grease over the inhibition by the guide fin 135.”
  - e. The abstract begins with a phrase that can be implied

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8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

*Claim Objections*

9. Claims 7 & 9 are objected to because in line 2 of each claim the limitation, “are formed as angular portion” should be changed to “are formed as angular portions”. Likewise at line 4, the limitation, “are formed as curved portion” should be changed to “are formed as curved portions”.

*Claim Rejections - 35 USC § 112*

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "said separated portion". There is insufficient antecedent basis for this limitation in the claim since no single separated portion is identified as “the separated portion”.

*Claim Rejections - 35 USC § 102*

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1 & 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Inuzuka et al, EP 1 101 982 (Inuzuka). Figs. 17 & 18 shows a boot 61 for a universal shaft coupling (see Fig. 14) formed by a rubber elastic body (page 13, line 5), and forming a bellows portion between a small-diameter ring portion 71 and a large-diameter ring portion 72,

wherein linear separated portions 74, 75 are formed along a generatrix from the small-diameter ring portion to the large-diameter ring portion, both sides of said separated portions are formed thick (see Fig. 18A), and a fastener pair 76, 77 is arranged in said separated portions, and a portion between said separated portions is thinner than said separated portions and is formed in a substantially uniform thickness so as to form a general portion connected in a peripheral direction,

wherein said fastener pair is constituted by a band-like occluding portion 76 formed along one end edge of said separated portion and provided with a bulge locking portion 762 in a leading end, and a band-like occluded portion 77 provided with a occluding groove (see “groove” at page 13, line 25) occluding with said occluding portion along another end edge of said separated portion, and

wherein a guide fin 773 provided with a guide surface at a position partly overlapping the occluding portion at a time of facing to said occluding portion, is formed so as to protrude only to a crest portion side 73a of said bellows portion, in an inner side (see also page 13, line 32) of said occluding groove on an occluded portion side end surface 774a of said separated portion.

*Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 6 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inuzuka in view of Maas, US 3,623,340. Inuzuka shows a boot comprising every limitation of the claims, but does not expressly disclose a grease return rib provided at the first inner peripheral surface in a side of the large diameter ring portion. In Figs. 1 & 2, Maas shows a boot 28 for a universal joint 20, the boot comprising a grease return rib 38 provided at the first inner peripheral surface in a side of the large diameter ring portion 29. At the abstract as well as col. 3, lines 18-23, Maas teaches making the boot with the grease return rib in order to provide a means to retain lubricant in the universal joint. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the boot of Inuzuka by making it with a grease return rib at the first inner peripheral surface in a side of the large diameter ring portion in order to provide a means to retain lubricant in the universal joint as taught by Maas.

16. Claims 7 & 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Inuzuka in view of Maas, as applied to claims 6 & 8 above, and further in view of Thiers et al, US 6,772,568 (Thiers). In Fig. 4, Inuzuka shows the angular portions a & b on the base portion of the bulge



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locking portion 16' of the occluding portion 14, but does not show the corresponding portion of the occluded portion 15 as curved. In Figs. 15-17, Thiers shows the corresponding portion 44 of an occluded portion 43 as curved and teaches at col. 11, lines 43-53 making the curved portion in order to provide a means of assembly mainly through horizontal movement. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Inuzuka and Maas by curving the corresponding portion of the occluded portion in order to provide a means of assembly mainly through horizontal movement as taught by Thiers.

#### *Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Richter shows a split boot.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Binda/  
Primary Examiner  
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